

REMARKS/ARGUMENTS

This is a preliminary amendment in a RCE Application. The Office Action mailed October 27, 2003 has been carefully reviewed. The claims presented for examination are claims 1–8. Applicants respectfully request reconsideration of this application as amended and in view of the enclosed Declarations and the following remarks.

Oath/Declaration

In numbered paragraph 3 of the Office Action mailed 10/27/2003, the oath or declaration was stated to be defective and a new oath or declaration was required. The reason stated was, “all signed date has been removed.”

Applicants respectfully submit that the original oaths were not defective; however, Applicants are interested in advancing prosecution of the subject application and are submitting new declarations as required in the Office Action mailed 10/27/2003. Applicants direct attention to the following provisions of the MPEP:

“MPEP § 715.07 Facts and Documentary Evidence
ESTABLISHMENT OF DATES

If the dates of the exhibits have been removed or blocked off, the matter of dates can be taken care of in the body of the oath or declaration.

When alleging that conception or a reduction to practice occurred prior to the effective date of the reference, the dates in the oath or declaration may be the actual dates or, if the applicant or patent owner does not desire to disclose his or her actual dates, he or she may merely allege that the acts referred to occurred prior to a specified date.”

It is within Applicants right to submit exhibits wherein the dates have been blacked out, as was the case with the declarations submitted previously by Applicants. Applicants are interested in advancing prosecution of the subject application and are submitting new declarations as required in the Office Action mailed 10/27/2003.

35 U.S.C. 102(e) Rejection

In numbered paragraph 1 of the Office Action mailed 10/27/2003, Claims 1 and 5-7 were rejected under 35 U.S.C. 102(e) as allegedly being anticipated by Injeyan et al (U.S. Patent No. 6,094,297).

Enclosed are declarations by Eric C. Honea, Raymond J. Beach, and Eddie E. Scott that establish that Applicants made the invention described and claimed in the subject patent application in this country prior to July 7, 1998 which is the filing date of the application from which The Cited Injeyan Reference, U.S. Patent No. 6,094,297, matured.

The declarations by Eric C. Honea, Raymond J. Beach, and Eddie E. Scott show: ATTACHMENT A "RECORD OF INVENTION" in the Conception of the Invention Section XIII, contains an entry for the "Conception Date," the entry is "May 1997" which is prior to the Injeyan et al filing date of July 7, 1998; the "Conception Place" entry "LLNL" is in this country (USA); ATTACHMENTS B, C, D and E are documents showing that The Inventors, Eric C. Honea and Raymond J. Beach, made The Invention in this country prior to July 7, 1998 (ATTACHMENT B), disclosed The Invention to others in this country prior to July 7, 1998 (ATTACHMENT C), disclosed The Invention to others in this country prior to July 7, 1998 and reduced The Invention to practice in this country prior to July 7, 1998 (ATTACHMENT D), that prototypes of The Invention were made and tested prior to July 7, 1998, and The Invention was to reduced to practice in this country prior to July 7, 1998 (ATTACHMENT E); during The Time Period the Industrial Partnership and Commercialization Office (IPAC) of the Lawrence Livermore National Laboratory held monthly Invention Review Meetings and The Invention was reviewed at the Invention Review Meetings during The Time Period; IPAC continuously reviews inventions and prioritizes inventions for patent application filing; The Invention was reviewed and prioritized by IPAC during The Time Period; a photostatic copy of a database entry showing that The Invention was reviewed by IPAC

during The Time Period is Attachment F; during The Time Period the Office of Laboratory Counsel (OLC) of the Lawrence Livermore National Laboratory, held monthly Invention Review Meetings and The Invention was reviewed at the Meetings during The Time Period; the Office of Laboratory Counsel (OLC) also held monthly meetings with the Industrial Partnership and Commercialization Office (IPAC) during The Time Period and The Invention was reviewed at the Meetings; OLC prepares patent applications for filing according to a priority list; the parent application of the subject application was prepared by OLC covering The Invention according to the priority list; a photostatic copy of a database entry showing that The Invention was reviewed and a patent application filed by OLC during The Time Period is Attachment G; during The Time Period The Invention was continuously worked on; photostatic copies of documents maintained in the ordinary course of business of the University of California, the Lawrence Livermore National Laboratory, and the United States Department of Energy (DOE) showing that The Invention was continuously worked on during The Time Period are Attachments H, I, J, K, L, M, N, O, P, Q, R, S, and T.

Applicants submit that The Cited Injeyan Reference, U.S. Patent No. 6,094,297, can not be used as a reference against the claims of the subject application. Thus, the Injeyan Reference fails to support a rejection of the claims under 35 USC 102, and the rejection should be withdrawn.

35 U.S.C. 103(a) Rejection

In numbered paragraph 2 of the Office Action mailed 10/27/2003, Claims 2-4 and 8 were rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Injeyan ('297) in view of Feng et al ('468) further in view of Connors et al ('555).

As explained above, the enclosed are declarations by Eric C. Honea, Raymond J. Beach, and Eddie E. Scott that establish that Applicants made the invention described and claimed in the subject patent application in this country prior to July 7, 1998 which is the filing date of the application from which The Cited Injeyan Reference, U.S. Patent

No. 6,094,297, matured. Applicants submit that The Cited Injeyan Reference, U.S. Patent No. 6,094,297, can not be used as a reference against the claims of the subject application. Since the Injeyan Reference, U.S. Patent No. 6,094,297, can not be used as a reference against the claims of the subject application the Feng et al ('468) and Connors et al ('555) references do not render the claimed invention unpatentable.

Thus, the combination of references fails to support a rejection of the claims under 35 USC 103, and the rejection should be withdrawn.

SUMMARY

The undersigned respectfully submits that, in view of the enclosed new "declarations" and the foregoing remarks, the rejections of the claims raised in the Office Action dated October 27, 2003 have been fully addressed and overcome, and the present application is believed to be in condition for allowance. It is respectfully requested that this application be reconsidered, that the claims be allowed, and that this case be passed to issue. If it is believed that a telephone conversation would expedite the prosecution of the present application, or clarify matters with regard to its allowance, the Examiner is invited to call the undersigned attorney at (925) 424-6897.

Respectfully submitted,



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